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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,157	04/24/2001	Yoshihiko Watanabe	35.C15213	3428

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EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/840,157		WATANABE ET AL.	
	Examiner		Art Unit	
	Peter K. Huntsinger		2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/15/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filled on 15 April 2005 has been entered in full.
2. Based on the applicant's amendment, the objection to claim 1 has been withdrawn.

Response to Argument

3. Applicant's arguments filled on 15 April 2005 regarding claims 24-38 have been fully considered but they are not persuasive.

On page 7 of the remarks, applicant argues in substance that:

4. **Kolls teaches payment of a charge by a prepaid card or coins.**
 - a. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., payment of a charge other than a prepaid card or coins) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Objections

5. Claim 35 is objected to because of the following informalities: On line 3 of claim 35, "a step of calculate the charge" should read "a step of calculating the charge".
- Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory subject matter because they fail to produce a useful, concrete, and tangible result. According to MPEP section 2106, "If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter." The computer data signal, print task, print task modifications, and print processor can all be represented as software consisting of binary numbers.

Further, according to MPEP section 2106, "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In

contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." Claim 21 does not specify a computer-readable media for the computer data signal.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 24-26, 28-31, 33-36, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls U.S. Patent 6,615,183.

Referring to claims 24, 29, and 34, Kolls discloses a file outputting system, method, and program comprising: file storing means (non-volatile memory 518 of Fig. 4) for storing a file which is formed using an application (col. 11, lines 15-19); receiving means (system 500) for receiving a request of output processing of the file stored by said file storing means (1202 of Fig. 14, col. 31, lines 44-49); output processing executing means (PC 630) for executing the requested output processing on the file (col. 6-7, lines 63-67, 1-5); output log recording means for recording an amount of

Art Unit: 2624

output product obtained by the output processing (60 of Fig. 1, col. 5, lines 19-21); and calculating means for calculating a charge for use of the application on the basis of the amount of the output product, recorded by said output log recording means (1718 of Fig. 19, col. 39, lines 62-65).

Referring to claims 25, 30, and 35, Kolls discloses a file outputting system, method, and program, further comprising unit price storing means for storing a unit price of the application, wherein said calculating means calculates the charge for use of the application on the basis of the unit price (col. 10, lines 26-40).

Referring to claims 26, 31, and 36, Kolls discloses a file outputting system, method, and program, wherein the output processing includes at least one of facsimile transmission, printing, and e-mail transmission (col. 6, lines 63-67).

Referring to claims 28, 33, and 38, Kolls discloses a file outputting system, method, and program, further comprising notifying means for notifying an accounting server which effects accounting processing, of the calculated charge for use of the application (col. 36, lines 54-61).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2624

10. Claims 27, 32, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S. Patent 6,615,183 as applied to claims 24, 29, and 34 above, and further in view of Crawford U.S. Patent 5,771,354.

Referring to claims 27, 32, and 37 Kolls discloses forming a file by using an application but does not disclose expressly transmitting the file to a server. Crawford discloses a file is formed using an application by a client apparatus connected to a network (col. 12-13, lines 59-67, 1-7), and then transmitted to a file server apparatus which includes said file storing means (col. 58, lines 8-17). Kolls and Crawford are in the same field of service vending systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to offer online storage services in the vending system of Kolls. The motivation for doing so would have been to provide a service to customers desiring to backup files. Therefore, it would have been obvious to combine Crawford with Kolls to obtain the invention as specified in claims 27, 32, and 37.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

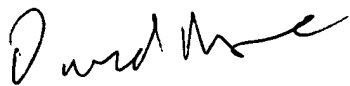
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH


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